

## **REMARKS**

### **I. Introduction**

Claims 15 to 32 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received. However, Applicant respectfully brings to the Examiner's attention an apparent error on page 2 of the Office Action wherein it is stated that "Application No. 102304130" was filed July 7, 2002. As indicated in the priority documents noted as received by the Examiner, the filing date of German Application No. 102 30 413.0 was July 6, 2002.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

### **II. Rejection of Claims 15 to 17, 19 to 26 and 28 to 32 Under 35 U.S.C. § 102(b)**

Claims 15 to 17, 19 to 26 and 28 to 32 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,736,789. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

U.S. Patent No. 6,736,789 is not prior art under 35 U.S.C. § 102(b) with respect to the present application. It is respectfully submitted that the earliest effective date of U.S. Patent No. 6,736,789 which the Examiner may use for prior art purposes under 35 U.S.C. § 102(b) is the date of the patent, May 18, 2004. The present application is the national stage of PCT International Patent Application No. PCT/WO03/05657 having an international filing date of May 30, 2003. The international filing date is also the filing date for the national stage application. See M.P.E.P. § 1893.03(b). Therefore, because the **May 18, 2004** date of U.S. Patent No. 6,736,789 is not more than one year prior to the **May 30, 2003** international filing date of the present application, it is respectfully submitted that U.S. Patent No. 6,736,789 does not constitute prior art to the present application under 35 U.S.C. § 102(b).

Furthermore, it is noted that U.S. Patent No. 6,736,789 is not prior art under 35 U.S.C. § 102(a) with respect to the present application because at least the

May 30, 2003 international filing date of the present application is earlier than the May 18, 2004 issue date of U.S. Patent No. 6,736,789.

Even assuming *arguendo* that U.S. Patent No. 6,736,789 is prior art under 35 U.S.C. § 102(e) with respect to the present application, it is respectfully submitted that U.S. Patent No. 6,736,789 does not anticipate either claim 15 or claim 24 for at least the following reasons.

To anticipate a claim, the reference must disclose each and every element of the claimed invention. *Verdergaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). Applicant respectfully submits that U.S. Patent No. 6,736,789 does not disclose each and every element of either claim 15 or 24.

Claims 15 and 24 each recite, *inter alia*, “generating pulse waves in the extracorporeal blood circuit, wherein the pulse waves have at least one of a propagation rate and a transit time ....” The Office Action argues at pages 2 and 3 that U.S. Patent No. 6,736,789 discloses a blood circuit that includes “means for generating and measuring pulse waves that have a propagation rate and transfer time.” In support of this position the Office Action cites column 2, lines 55 to 61 of U.S. Patent No. 6,736,789. Column 2, lines 55 to 61, however, provide that “continuous, noninvasive blood pressure measurement is based on detection of the propagation rate of the pulse waves produced by contractions of the cardiac contractions propagating through the patient’s arterial system.” (emphasis added). Thus, unlike claim 15 or claim 24, where the pulse waves are generated in the extracorporeal blood circuit, the pulse waves in U.S. Patent No. 6,736,789 are actually produced by contraction of the cardiac contraction propagating through the patient’s arterial system, *i.e.*, the patient’s body. Accordingly, U.S. Patent No. 6,736,789 fails to disclose at least the feature of “generating pulse waves in the extracorporeal blood circuit wherein the pulse waves have at least one of a propagation rate and a transit time,” as recited in each of claims 15 and 24.

As for claims 16, 17, 19 to 23, 25, 26 and 28 to 32, which ultimately depend from either claim 15 or claim 24, it is respectfully submitted that U.S. Patent No. 6,736,789 does not anticipate these dependent claims for at least the same reasons more fully set forth above.

In view of all of the foregoing, it is respectfully submitted that the present rejection is moot, and withdrawal of this rejection is respectfully requested.

**III. Rejection of Claims 18 and 27 Under 35 U.S.C. § 103(a)**

Claims 18 and 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,736,789 and U.S. Patent No. 6,966,979.

Applicant respectfully submits that, under 35 U.S.C. § 103(c), U.S. Patent No. 6,736,789 cannot be used for the purposes of determining obviousness under 35 U.S.C. § 103(a). Because the present application was filed subsequent to November 29, 1999, the provisions of 35 U.S.C. § 103(c) as amended by Public Law 106-113, § 1000(a)(9) apply to the present application. Section 103(c), as amended, applies to all utility patent applications filed on or after November 29, 1999 and provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As set forth above, U.S. Patent No. 6,736,789 is not prior art to the present application under either 35 U.S.C. § 102(a) or (b). As such, U.S. Patent No. 6,736,789 constitutes prior art against the present application, if at all, only under one or more of subsections (e), (f), and (g) of 35 U.S.C. § 102.

Assuming *arguendo* U.S. Patent No. 6,736,789 is prior art under 35 U.S.C. § 102(e), the present application and U.S. Patent No. 6,736,789 “were, at the time the invention [of the present application] was made, owned by . . . or subject to an obligation of assignment to” Fresenius Medical Care Deutschland GmbH. In this regard, by an assignment recorded in the records of the United States Patent and Trademark Office on July 5, 2005, at Reel 016740, Frame 0246, the entire right, title and interest in and to the present application was assigned to Fresenius Medical Care Deutschland GmbH. U.S. Patent No. 6,736,789 is assigned on its face to Fresenius Medical Care Deutschland GmbH. It is therefore respectfully submitted that, under 35 U.S.C. § 103(c), U.S. Patent No. 6,736,789 cannot be used to reject any claim of the present application under 35 U.S.C. § 103(a).

Even assuming *arguendo* that the subject matter of U.S. Patent No. 6,736,789 could be used as a reference under 35 U.S.C. § 103(a), the combination of U.S. Patent No. 6,736,789 and U.S. Patent No. 6,966,979 would not render claims 18 and 27 unpatentable. Claims 18 and 27 ultimately depend from independent claims 15 and 24, respectively, and include all the features recited in each of their respective independent claims. Thus, claims 18 and 27 include, *inter alia*, the feature of "generating pulse waves in the extracorporeal blood circuit, wherein the pulse waves have at least one of a propagation rate and a transit time ...." Neither U.S. Patent No. 6,736,789 nor U.S. Patent No. 6,966,979 disclose at least this feature.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**IV. Information Disclosure Statement**

Applicant also submits herewith an Information Disclosure Statement listing German publication DE 197 46 377 C1, which is a member of the patent family of above-mentioned U.S. Patent No. 6,736,789. It is respectfully requested that this Information Disclosure Statement be expressly considered during the prosecution of this application.


**V. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,  
KENYON & KENYON LLP

Date: December 28, 2006

By:

  
\_\_\_\_\_  
Kevin T. Godlewski  
Reg. No. 47,598

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO. 26646**